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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT SESEK

Appeal 2009-000961
Application 09/776,057
Technology Center 2600

Decided: September 28, 2009

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT, and KARL D.
EASTHOM, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 21-23, 26-28, 31, and 34-37, which are all of the pending claims. Claims 1-20, 24, 25, 29, 30, 32, and 33 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (filed August 16, 2007), the Answer (mailed November 15, 2007), and the Reply Brief (filed January 9, 2008) for the respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant's Invention

Appellant's invention relates to the securing of print jobs such that print jobs are only executed by a printer or authorized individuals who are present at the printer. Biometric signatures (e.g., fingerprints, retinal patterns, and voice patterns) are associated with a print job sent from a host computer to the printer to which is connected a biometric identification device. The print job will not be printed unless a biometric signature entered with the biometric identification device at the printer matches the biometric signature associated with the print job. (*See generally* Spec. 3:26-4:11).

Claim 21 is illustrative of the invention and reads as follows:

21. A method, comprising:

the printer displaying a plurality of pending secured print jobs each having an authorized bio signature associated therewith;

the printer receiving a selection of one of the secured print jobs for printing;

the printer comparing an entered bio signature for a user to the authorized bio signature for the selected print job; and

the printer printing the selected print job if the entered bio signature matches the authorized bio signature for the selected print job.

The Examiner's Rejections

The Examiner's Answer cites the following prior art references:

Nerlikar	US 5,629,981	May 13, 1997
Drabble	WO 00/62474	Oct. 19, 2000
Olsen	US 6,952,780 B2	Oct. 4, 2005 (filed Jan. 26, 2001)

Claims 21-23, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nerlikar in view of Olsen.

Claims 27, 28, 31, and 34-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drabble in view of "well known prior art."

ISSUES

The pivotal issues before us are whether Appellant has demonstrated that the Examiner erred in determining the obviousness to the ordinarily skilled artisan of

- a) combining Olsen's teachings of displaying a list of a plurality of pending secured print jobs available for selection with Nerlikar's teaching of comparing biometric signatures of a user with an associated biometric signature for a selected print job to authorize printing, and
- b) combining the collective teachings of Drabble and the "well known prior art" of entering a biometric signature at a printer to authorize

printing and associating a plurality of biometric signatures with a single print job.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Nerlikar discloses (Fig. 1, col. 12, ll. 13-42) the printing of a secure print job if a biometric signature of a user matches a biometric signature associated with the print job.
2. Nerlikar further discloses (col. 12, ll. 21-24) an indicator light which flashes on a receiving facsimile machine when a secure document is waiting for retrieval by an authorized user.
3. Nerlikar also discloses (col. 6, ll. 34-35) that a user segment of Nerlikar's system "is comprised of individuals wishing to send and receive information such as secure documents."
4. Olsen discloses (Fig. 2, col. 6, ll. 11-20, and col. 10, ll. 51-54) the printing of secure print jobs in which a verified user can review and select from a displayed list of plural pending secure print jobs having an associated biometric signature which are available for selection.
5. Drabble discloses (Fig. 1) a printing system having biometric identification devices associated with sending computer 10 and receiving computer 11.
6. Drabble also discloses (page 4, ll. 21-22) that a received encryption decoded transmitted document by receiving computer 11 "can either be displayed on the screen of the computer 11 or printed out."

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

I. The rejection of claims 21-23 and 26 based on the combination of Nerlikar and Olsen.

With respect to the Examiner’s obviousness rejection of representative independent claim 21 based on the combination of Nerlikar and Olsen, Appellant’s arguments in response assert a failure by the Examiner to

establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references.¹ Appellant's arguments do not attack the Examiner's basis for combining Nerlikar and Olsen but, rather, initially focus on the alleged deficiency of Nerlikar in disclosing the claimed feature of displaying a plurality of pending secure print jobs each having an associated biometric signature. According to Appellant (App. Br. 4; Reply Br. 1-2), Nerlikar discloses only a single document faxed from one individual to another and, further, has no disclosure that even the one single document is displayed as a pending print job on the printer as claimed.

We do not agree with Appellant. We find no error in the Examiner's determination (Ans. 4) that Nerlikar's disclosure (FF 2) of an indicator light which flashes on the receiving fax machine when a secured document is waiting for retrieval corresponds to the claimed display of a pending secured print job at a printer. We further do not necessarily disagree with the Examiner's finding (Ans. 3 and 9) that an ordinarily skilled artisan would recognize, that although Nerlikar discloses, by example, only a single secure communication between two individuals, that more than one secure document can be sent. For example, Nerlikar (FF 3) contemplates plural individuals sending plural documents as suggested at column 6, lines 34-35 which states that a user segment of Nerlikar's system "is comprised of

¹ Appellant argues rejected claims 21-23 and 26 together as a group making particular reference solely to independent claim 21. *See* App. Br. 3-5. Accordingly, we select claim 21 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

individuals wishing to send and receive information such as secure documents.”

In any case, we find that any considered deficiency of Nerlikar in disclosing the sending of plural documents is overcome by the Examiner’s application of the teachings of Olsen. We agree with the Examiner (Ans. 4 and 10) that Olsen provides a disclosure (FF 4) that a verified user can review and select a print job from a displayed list of available plural pending secure print jobs having associated biometric signatures. As such, we find that Olsen’s teachings correspond to what is required by at least the first two method steps in appealed claim 21.

We also do not find Appellant’s arguments with respect to Olsen to be convincing of any error in the Examiner’s stated position. Appellant’s arguments (App. Br. 4; Reply Br. 3-4) focus on the contention that, unlike the present invention in which all pending print jobs are displayed at the printer, Olsen displays only the pending print jobs that a verified user is authorized to print.

We find, however, that even if we assume, *arguendo*, that Appellant is correct that Olsen discloses signature comparison *before* a list of print job is displayed, we find that Nerlikar discloses the comparison of signatures and the printing of a selected print job upon a successful comparison verification in accordance with last two steps of claim 21. Even further, we find that the scenario described in Example 1 of Nerlikar discloses (col. 12, ll. 13-42) that the signature comparison verification takes place *after* a display of a pending print job is indicated at the printer.

Further, while we do not necessarily disagree with Appellant’s interpretation of the disclosure of Olsen, we do not find in the language of

claim 21 where the comparing of biometric signatures *before* a list of pending print jobs is displayed is precluded. Also, we do not interpret the Examiner's position as suggesting the bodily incorporation of the plural secure print job printing system of Olsen into the secure document communication system of Nerlikar. Rather, it is Olsen's teaching (FF 4) of displaying a *plurality* of pending secure print jobs that is relied upon as a rationale for the proposed combination with Nerlikar's document communication system. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." See *In re Keller*, 642 F.2d 414, 425 (CCPA 1981) and *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973).

For the above reasons, since it is our opinion that the Examiner has established a *prima facie* case of obviousness based on the combination of Nerlikar and Olsen which has not been overcome by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of representative independent claim 21, as well as claims 22, 23, and 26 not separately argued by Appellant, is sustained.

II. The rejection of claims 27, 28, 31, and 34-37 based on the combination of Drabble and "well known prior art."

We also sustain the Examiner's obviousness rejections of independent claims 27 and 36, as well as dependent claims 28, 31, 34, 35, and 37 which are not separately argued by Appellant. With respect to independent claim 27, Appellant contends that the Examiner erred in determining that the

receiving computer 11 of Drabble corresponds to the claimed printer in which biometric signatures are entered directly into the printer. According to Appellant (App. Br. 5-6), there is no teaching or suggestion in Drabble that the receiving computer 11 has any printing function.

We are not persuaded by Appellant's arguments. We find that Drabble has an explicit teaching that receiving computer 11 has an associated printing function since a received encryption decoded transmitted document "can either be displayed on the screen of the computer 11 or printed out." (FF 6). Further we find no error, and there are no convincing arguments from Appellant, in the Examiner's line of reasoning (Ans. 5, 6, 11, and 12) that an ordinarily skilled artisan would have recognized and appreciated that computers that receive communicated documents would have an associated printer or that Drabble's disclosed receiving computer 11 with an attached biometric device (Fig. 1) would encompass secure document printing systems with computing functions such as facsimile machines. With respect to independent claim 36, we similarly find no persuasive arguments from Appellant that convince us of any error in the Examiner's finding (Ans. 6-7) that an ordinarily skilled artisan would have recognized and appreciated that, in Drabble, a secure image/e-mail communication can be transmitted to more than one recipient, each of which would require an authorized biometric signature for receipt.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not shown that the Examiner erred in rejecting appealed claims 21-23, 26-28, 31, and 34-37 for obviousness under 35 U.S.C. § 103.

DECISION

The Examiner's 35 U.S.C. § 103 rejection of claims 21-23, 26-28, 31, and 34-37, all of the appealed claims, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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